Supreme Court, U.S.
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In The

Supreme Court of the United States

SOUTHCO, INC.,

Petitioner,

v.

KANEBRIDGE CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Third Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether digital works which are produced by the rules of a numbering system created by the author are categorically uncopyrightable.

2. Whether digital works which have nine or fewer digits are categorically uncopyrightable.

RULE 29.6 DISCLOSURE STATEMENT

Southco, Inc. is a wholly-owned subsidiary of South Chester Tube Company, a Pennsylvania corporation. There are no subsidiaries or affiliates of South Chester Tube Company or Southco, Inc. that have issued shares to the public.

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OPINIONS AND ORDERS BELOW

The January 12, 2000 Opinion and Order of the District Court for the Eastern District of Pennsylvania, granting Southco a preliminary injunction is reported at *Southco, Inc. v. Kanebridge Corp.*, 2000 U.S. Dist. LEXIS 112, 53 U.S.P.Q.2d (BNA) 1490 (E.D. Pa. Jan. 12, 2000) and is reproduced at App. 50-67.

The July 20, 2001 Opinion of the Court of Appeals for the Third Circuit reversing the preliminary injunction is reported at *Southco, Inc. v. Kanebridge Corp.*, 258 F.3d 148, 2001 U.S. App. LEXIS 16245, 59 U.S.P.Q.2d (BNA) 1514 (3d Cir. Pa. 2001) and is reproduced at App. 68-85.

The November 15, 2001 Order of the District Court granting Kanebridge summary judgment dismissing Southco's copyright claim is unreported and is reproduced at App. 86-90.

The March 26, 2003 Opinion of the Court of Appeals for the Third Circuit reversing the summary judgment is reported at 324 F.3d 190, 2003 U.S. App. LEXIS 5857, 66 U.S.P.Q.2d (BNA) 1308 (3d Cir. Pa. 2003) and is reproduced at App. 91-104.

The April 25, 2003 Order of the Court of Appeals granting rehearing *en banc* and vacating the panel decision is reported at *Southco, Inc. v. Kanebridge Corp.*, 2003 U.S. App. LEXIS 9786 (3d Cir. Pa. Apr. 25, 2003), reproduced at App. 195.

The September 18, 2003 Order of the Court of Appeals for the Third Circuit that it will hear argument on the issues involving the merits of the case only, in particular, copyrightability and the fair use doctrine is unreported and is reproduced at App. 193-194.

The December 3, 2004 Opinion of the Court of Appeals for the Third Circuit *en banc*, affirming the summary judgment dismissing the copyright complaint, as amended December 8, 2004 and December 13, 2004 is reported at 390 F.3d 276, 2004 U.S. App. LEXIS 24935, 73 U.S.P.Q.2d (BNA) 1071 (3d Cir. Pa. 2004) and is reproduced at App. 1-49.

The January 31, 2005 order Sur Petition For Rehearing, denying the petition for rehearing is unreported and is reproduced at App. 106-107.

The April 11, 2005 Order of the Court of Appeals for the Third Circuit granting Southco access to cited authority is unreported and is reproduced at App. 105.

JURISDICTION

The Judgment of the Court of Appeals for the Third Circuit affirming the summary judgment dismissing Petitioner's copyright complaint was entered on December 3, 2004.

The Order of the Court of Appeals denying Petitioner's petition for rehearing was entered on January 31, 2005. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

1. Article 1, Section 8, Clause 8 of the Constitution provides:

> [Congress shall have the power] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

2. Section 102(a)(1), Title 17, U.S.C. provides:

> Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (1) literary works; . . .

3. Section 101, Title 17, U.S.C. provides:

> "Literary works" are works, . . . expressed in words, numbers, or other verbal or numerical symbols or indicia, . . .

4. Section 102(b), Title 17, U.S.C. provides:

> In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

5. Section 202.1, 37 C.F.R, provides:

> The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained: (a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs; mere variations of typographical ornamentation, lettering or coloring; mere listing of ingredients or contents. . . .

STATEMENT OF THE CASE

This case concerns the copyrightability of digital works in which each digit conveys codified information. Although the digital works are referred to as "part numbers," they are not numbers as such: the digits have only symbolic value. These digital works are used in manufacturing and marketing captive screws, which are a type of fastener. App. 2-3, 51-53.

The Bisbing Declaration is the evidence in this case of the creation of the numbers.[1] Mr. Bisbing both designed the captive screws and created the numbers. He first determined upon the characteristics or other values of the fasteners that he wished to reflect in the part numbers. He then created the digits by selecting the numerals and the range of the numerals for each digit in the nine-digit number. The range of numerals depended upon the number of values he wished each digit to reflect. The numbers were created digit-by-digit, with the ranges of numerals for each digit corresponding to each of the numbers. By

[1] The Bisbing Declaration, cited herein as "Bisbing," is filed under seal in this Court to protect confidential manufacturing information.

this means, all of the numbers in the system were created at the same time. Bisbing, ¶¶ 10-19.

The present civil action was filed when Kanebridge copied Southco's part numbers and began using them in its advertising material for marketing its own products. Kanebridge and its customers were invited to use Southco's part numbers for the selection and manufacturing of Kanebridge's captive screws. App. 52, 62.

Southco moved for and was granted a preliminary injunction by the district court. App. 66. It was reversed on appeal. App. 68-85 (Southco I). Upon remand, the district court entered summary judgment against Southco solely on the basis that the appellate ruling was the law of the case. App. 86-90. On Southco's appeal, a second panel reversed the summary judgment and remanded for consideration of the Bisbing affidavit. App. 91-104. (Southco II). On Kanebridge's motion for rehearing, the Third Circuit *en banc* vacated the second panel's ruling and affirmed the summary judgment, not on the law of the case, but on the merits, ruling that the part numbers were categorically uncopyrightable as a matter of law. App. 1-49. (Southco III).

REASONS FOR GRANTING THE PETITION

1. The Third Circuit Decision Has A Potentially Significant National Impact

The judges of the Third Circuit, in the majority and in dissent, agree that the decision in this case will have a broad impact. The majority based its decision in part upon the expectation that it would affect "a huge number" of part and product numbers "and other analogous numbers." App. 20. The dissent predicted that the decision could deny copyright protection to "large swaths of rule-based original works." App. 41.[2]

The Third Circuit decision declares two categories of works to be uncopyrightable: digital works of nine or fewer digits, however creative; and works of any length which are produced by the rules of a system. App. 11, 17, 18, 20. The first category, of course, excludes over one billion digital works from copyright protection, regardless of their creativity. The second category excludes an incalculably large number of original works. The "huge number" of "analogous" numbers would include computer object code which is a perfect example of a string of numbers mechanically produced by the inflexible rules of a system. Computer operating instructions written in source code

[2] In response, the majority stated that it was deciding "what is before us, i.e., the Southco part numbers," (App. 21, n.7), but, at the same time stated that "other analogous numbers" would be affected by its decision. App. 20. As a precedential decision, it will clearly cover subject matter falling precisely within the court's rule of decision.